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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,827	10/11/2001	Mitsuyuki Hatanaka	275785US6	2274
22850	7590	01/22/2008		EXAMINER
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				GYORFI, THOMAS A
			ART UNIT	PAPER NUMBER
			2135	
				NOTIFICATION DATE      DELIVERY MODE
				01/22/2008      ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/975,827	HATANAKA ET AL.	
	Examiner Tom Gyorfi	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 05 November 2007.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-15, 17-19, 21-23 and 25-34 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-15, 17-19, 21-23 and 25-34 is/are rejected.

7)  Claim(s) 23 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application

6)  Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-15, 17-19, 21-23, and 25-34 remain for examination. The amendment filed 11/5/07 amended claims 1, 3-6, 8, 9, 11, 13-15, 18, 19, 22, 23, and 28-34.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Objections***

3. Claim 23 is objected to because of the following informalities: the claim was amended to include new limitation(s), but its status is listed as "Previously Presented".

#### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-15, 17-19, 21-23, and 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoda (U.S. Patent 7,096,268) in view of the iTunes software product, as disclosed in both Robbin (U.S. Patent 6,731,312) and the iBasics references: "Encode, Organize, Radio, and Play" [part 1] and "Burning CDs" [part 2].

For purposes of the rejections that follow, the combination of the Robbin patent with the iBasics references should be self-evident, as all the references are describing various aspects of the same software product. Nevertheless, assuming *arguendo* that

this were not the case, it would still be obvious to combine any feature disclosed in one reference to the invention but not in another reference, as the features disclosed in each reference are techniques for improving the performance of media playing software were all part of the ordinary capabilities of a person of ordinary skill in the art, in view of teaching said techniques for improvement in related media playing software products.

See also *KSR v. Teleflex*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 and MPEP § 2141.

Regarding claims 1, 3, and 4:

Shoda discloses an information processing method/apparatus/program having functions for recording contents on a first recording medium onto a storage unit of said apparatus, said apparatus comprising: a recording unit for recording the contents of the first recording medium onto the storage unit (col. 6, lines 53-56); a storing unit for storing information regarding each track on the first recording medium as recording history information in said apparatus at the time the contents of the first recording medium are recorded onto the storage unit by said recording unit (col. 6, lines 58-67); a determining unit for determining whether a track on the first recording medium was previously recorded or not onto the storage unit by said recording unit based on said recording history information stored in said apparatus (col. 8, lines 23-55); a display (element 21 of Figure 1) and a display control unit for controlling display of information regarding tracks (Ibid, and col. 9, lines 23-50).

As acknowledged by Applicant in the amendment of 3/19/07, the Shoda reference is at the very least capable of determining which tracks have been previously

recorded [i.e. "ripped"] onto the apparatus (page 19, regarding the tracks "AAAAA" and "BBBBB"; cf. Shoda, col. 9, lines 38-47). However, the iTunes references disclose an analogous media player interface capable of allowing a user to use a graphical user interface on a display unit to import tracks from a CD to the device's internal storage unit (see iBasics part 1, "Encoding MP3 files", pages 1-4) including the steps wherein said display control unit is configured to initially provide a display indicating any track on the first recording medium with an associated selection box, said display unit being further configured to permit inserting a mark into each displayed selection box in order to select the track associated with the selection box containing the inserted mark for recording by said recording unit from the first recording medium onto the storage unit (iBasics, part 1: see the checkboxes next to each individual track on the CD "Brave New World" in the illustration on page 2; and part 2, page 2, 3<sup>rd</sup> paragraph; see also Robbin, col. 2, lines 55-62) and to permit removing any mark previously inserted into any selection box to deselect the track associated with the mark so removed so that the recording by said recording unit from the first recording medium onto the storage unit does not occur for any of the associated tracks with marks removed from their associated selection box (Ibid). The claim is thus obvious because the technique of using a graphical user interface to manipulate which tracks should be imported was part of the ordinary capabilities of one of ordinary skill in the art, as evidenced by the use of the very same technique in analogous prior art. Additionally, it is observed that iTunes is also capable of discerning and remembering which tracks have already been recorded in the storage are stored in the internal storage device (by definition, any track

that has been imported is recorded in the Library: iBasics, part 1, page 3; Robbin, col. 2, line 63 – col. 3, line 4).

Regarding claims 14, 18, and 22:

Shoda discloses an information processing method/apparatus/program for transferring contents from a first recording medium to a second recording medium, said apparatus comprising: means for determining whether or not recorded history information is present in the apparatus for the contents of the first recording medium (col. 8, lines 23-50); means for selecting a portion or portions of the contents for recording from the first recording medium to the second medium (col. 7, lines 4-12, and Figure 7); means for recording the selected portion from the first recording medium to the second recording medium (col. 8, line 61 – col. 9, line 2); means for storing the recorded history information regarding the selected portion[s] of the recorded contents (col. 7, line 55-col. 8, line 12); means for displaying on the apparatus a list indicating the selected portion[s] and non-selected portion[s] of the content (Figure 13a); wherein said recording means records from the first recording medium to the second recording medium the displayed portion[s] (col. 6, lines 34-40).

As acknowledged by Applicant in the amendment of 3/19/07, the Shoda reference is at the very least capable of determining which tracks have been previously recorded [i.e. “ripped”] onto the apparatus (page 19, regarding the tracks “AAAAA” and “BBBBB”; cf. Shoda, col. 9, lines 38-47). However, the iTunes references disclose an analogous media player interface capable of allowing a user to use a graphical user

interface on a display unit to import tracks from a CD to the device's internal storage unit (see iBasics part 1, "Encoding MP3 files", pages 1-4) including the steps wherein said display control unit is configured to initially provide a display indicating any track on the first recording medium with an associated selection box, said display unit being further configured to permit inserting a mark into each displayed selection box in order to select the track associated with the selection box containing the inserted mark for recording by said recording unit from the first recording medium onto the storage unit (iBasics, part 1: see the checkboxes next to each individual track on the CD "Brave New World" in the illustration on page 2; and part 2, page 2, 3<sup>rd</sup> paragraph; see also Robbin, col. 2, lines 55-62) and to permit removing any mark previously inserted into any selection box to deselect the track associated with the mark so removed so that the recording by said recording unit from the first recording medium onto the storage unit does not occur for any of the associated tracks with marks removed from their associated selection box (Ibid). The claim is thus obvious because the technique of using a graphical user interface to manipulate which tracks should be imported was part of the ordinary capabilities of one of ordinary skill in the art, as evidenced by the use of the very same technique in analogous prior art. Additionally, it is observed that iTunes is also capable of discerning and remembering which tracks have already been recorded in the storage are stored in the internal storage device (by definition, any track that has been imported is recorded in the Library: iBasics, part 1, page 3; Robbin, col. 2, line 63 – col. 3, line 4).

Regarding claims 29, 31, and 33:

Shoda discloses an information processing method/apparatus/program for recording contents stored on a recording medium, comprising: a storage unit configured to store recording history information (col. 6, lines 58-67); a determining unit configured to determine whether or not one or more tracks on the recording medium were previously recorded onto said storage unit based on said recording history information (col. 8, lines 23-55); a display configured to display one or more selected tracks for recording from the recording medium onto said storage unit (element 21 of Figure 1; Figure 13a); a display control unit configured to control a display of information on said display (Ibid); and a recording unit configured to record one or more selected tracks from the first recording medium onto said storage unit (col. 6, lines 53-56).

As acknowledged by Applicant in the amendment of 3/19/07, the Shoda reference is at the very least capable of determining which tracks have been previously recorded [i.e. "ripped"] onto the apparatus (page 19, regarding the tracks "AAAAA" and "BBBBB"; cf. Shoda, col. 9, lines 38-47). However, the iTunes references disclose an analogous media player interface capable of allowing a user to use a graphical user interface on a display unit to import tracks from a CD to the device's internal storage unit (see iBasics part 1, "Encoding MP3 files", pages 1-4) including the steps wherein said display control unit is configured to initially provide a display indicating any track on the first recording medium with an associated selection box, said display unit being further configured to permit inserting a mark into each displayed selection box in order to select the track associated with the selection box containing the inserted mark for

recording by said recording unit from the first recording medium onto the storage unit (iBasics, part 1: see the checkboxes next to each individual track on the CD "Brave New World" in the illustration on page 2; and part 2, page 2, 3<sup>rd</sup> paragraph; see also Robbin, col. 2, lines 55-62) and to permit removing any mark previously inserted into any selection box to deselect the track associated with the mark so removed so that the recording by said recording unit from the first recording medium onto the storage unit does not occur for any of the associated tracks with marks removed from their associated selection box (Ibid). The claim is thus obvious because the technique of using a graphical user interface to manipulate which tracks should be imported was part of the ordinary capabilities of one of ordinary skill in the art, as evidenced by the use of the very same technique in analogous prior art. Additionally, it is observed that iTunes is also capable of discerning and remembering which tracks have already been recorded in the storage are stored in the internal storage device (by definition, any track that has been imported is recorded in the Library: iBasics, part 1, page 3; Robbin, col. 2, line 63 – col. 3, line 4).

Regarding claim 2:

Shoda and iTunes further disclose wherein said recording history information contains audio recording history information which records the number of times that audio recording has been made for each track of the first recording medium, title saving information of the contents, and play list information (Shoda: col. 5, line 65 – col. 6, line 7; col. 7, lines 55-65; Robbin, Figures 1-10).

Regarding claims 5, 8, and 11:

Shoda further discloses a check-in unit for rendering unusable the contents recorded onto a second medium from the first recording medium (col. 7, line 55 – col. 8, line 12), wherein storing unit is further configured for storing information regarding the contents as recording history information onto the second recording medium being rendered unusable (col. 8, lines 13-55); wherein said recording history information includes a check-out number which is decremented when said recording unit records the contents on the first recording medium onto the second recording medium, and incremented when said check-in unit renders unusable the contents recorded onto the second recording medium from the first recording medium (Ibid, and col. 8, line 61 – col. 9, line 12).

Regarding claims 6, 9, 12, 15, 19, 23, 30, 32, and 34:

iTunes further discloses wherein inserting of the mark into the associated selection box and the clearing any mark inserted into any selection box to deselect the track associated with the mark so cleared are responsive to manual selection or de-selection operations (iBasics, part 1: figure on page 2; Robbin, col. 2, lines 55-62).

Regarding claims 7, 10, 13, 17, 21, and 25:

Shoda and iTunes further disclose wherein said display control unit displays indicia indicating whether or not recorded history information is present in said

apparatus for the contents of the first recording medium (Shoda: e.g. Figures 7 and 9; iTunes, via the Robbin reference, Figures 6-10).

Regarding claims 26-28:

Shoda and iTunes further discloses a judging unit for judging whether a predetermined recording medium is mounted to the apparatus based on a media specific identification information (Shoda: col. 5, lines 25-30; element 67 of Figure 7; iBasics part 1, page 1, "Encoding MP3 Files"); wherein said storing unit stores the recording history information associating with media specific information of the first recording medium (Shoda: col. 9, lines 3-12; iBasics, Ibid and also the illustration on page 2) and wherein said determining unit determines when the first recording medium is mounted (Shoda: col. 5, lines 25-30; iBasics, Ibid).

### **Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: "Review: iTunes 1.0" by Daniel Chvatik.
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is

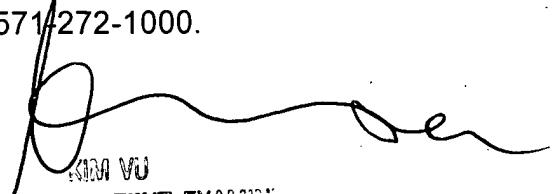
not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG  
1/10/08

  
KIM VU  
PATENT EXAMINER  
ART UNIT 2135